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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,881	12/05/2003	Jeffrey Jennings Krueger	KC-19,203	9190

7590 03/22/2006

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EXAMINER

ZEMEL, IRINA SOPJIA

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/729,881	KRUEGER ET AL.	
	Examiner	Art Unit	
	Irina S. Zemel	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 5-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>2-2-06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The rejections not addressed below are deemed withdrawn.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 2, 5--39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Federico in combination with Miller

The rejection stands as per reasons of record, incorporated in the instant rejection by reference.

Federico discloses flexible soft absorbent open cell foams comprising polystyrene and surfactant (non-ionic or mixed). The reference further expressly states that in order to improve the liquid intake of the foams, up to 30 % by weight of high impact polystyrene thermoplastic elastomer can be added to the compositions. See, for example, column 3, lines 15-21 and illustrative examples. Further addition of di- or tri-block copolymers to the compositions of Federico in the amounts of up to *about* 10 parts by weight would have been obvious from teachings of Miller who expressly discloses that addition of plasticizers and elastomers (including di-or tri-block elastomers) improves processing of styrene-base foams (as per column 7, lines 1-38 of Miller). See discussion above regarding di-/ tri- block elastomer amounts and ratios in the previous office action. The amounts of claimed elastomers (in combination) clearly meet the claimed limitation. Also, since the Miller reference discloses "about 10 parts by weight",

the reference does not specify the amounts with any specificity or exactitude, thus implying that higher amounts are equally suitable in the absence of showing of unexpected results or showing that addition of higher amounts would result in material change in the composition properties.

The Federico reference does not address the physical properties claimed in the instant application, however, as per discussion above, it is believed that the disclosed modified foams would inherently exhibit the claimed properties. The burden is shifted to the applicants to provide factual evidence to the contrary.

Response to Arguments

Applicant's arguments filed 1-3-2006 have been fully considered but they are not persuasive. The applicants argue that the invention disclosed by Federico is concerned with food trays and such products can not be soft and flexible. The applicants further state that the compositions disclosed by Federico do not contain thermoplastic elastomers or other ingredients that would make the trays soft and flexible. First of all, note that majority of the claims of the instant application do not require the foams to be soft or flexible. Second of all, the reference does expressly disclose incorporation of butadiene based rubbers in the amounts of up to 30 % to improve absorbency. Moreover, contrary to the applicants statement, the reference recognizes that increased absorption capacity leads to inevitable loss of mechanical strength, i.e., softer and more flexible materials, and this softening effect is offset by laminating harder plastic materials. See, for example, disclosure in column 4, lines 5 et seq. The

Art Unit: 1711

applicants further state that the Federico reference does not describe the foams as having a fluid intake of about 1 ml/sec/in² or greater. While it may be so, simply because the reference is silent to a given property of the disclosed product, it does not mean that the claimed property is not inherently present in the product. The applicants argue that comparative results utilizing commercially available polystyrene show that the claimed fluid intake flux characteristics are not met by such commercial polystyrene. The comparative results utilizing commercially available polystyrene is not considered to be the closest prior art comparison, since the compositions disclosed in the Federico reference are much closer to the claimed compositions and contain all of the claimed components, including polybutadiene based impact resistant components. Note that none of the claims requires the elastomers to be entirely of the block structure, and only require, with some claims requiring the elastomers to comprise such block copolymers. Moreover, incorporation of block copolymers (in addition to other elastomeric components) would have been obvious from the disclosure of Miller (as discussed above and in the previous office action) in the amounts up to about 10 parts by weight to 100 parts by weight of the polystyrene component, although such an addition may be obvious for different reasons than the applicants reasons. It has been long established by the case law that the reason or motivation to modify the reference may often suggest what the inventor has done, but for a different purpose or to solve a different problem. It is not necessary that the prior art suggest the combination to achieve the same advantage or result discovered by applicant. *In re Linter*, 458 F.2d 1013, 173 USPQ 560 (CCPA 1972) (discussed below); *In re Dillon*, 919 F.2d 688, 16 USPQ2d 1897 (Fed. Cir.

Art Unit: 1711

1990). The court also stated that claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). Thus, discovering that addition of specified elastomer results in some improved property, where such an addition is otherwise obvious, does not support patentability unless showing of unexpected results **commensurate in scope** with the claimed invention are presented on the record.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

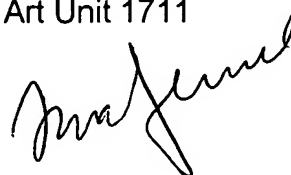
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Irina S. Zemel whose telephone number is (571)272-0577. The examiner can normally be reached on Monday-Friday 9-5.

Art Unit: 1711

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571)272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Irina S. Zemel
Examiner
Art Unit 1711

A handwritten signature in black ink, appearing to read 'Irina Zemel', written over the printed name.

ISZ